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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,113	12/02/2003	Steven E. Wallis		4802

7590 10/27/2006
Steven E. Wallis
1656 Wynoochee Way
Petaluma, CA 94954

EXAMINER

FRISBY, KESHA

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,113

Applicant(s)

WALLIS ET AL.

Examiner

Kesha Frisby

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Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to because in sections A, C & E the letter "o" is missing in some of the words, for example "supp rts". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the examiner would suggest that the abstract first sentence reads as follows: "A method for improving the way ... Neuro-linguistic Programming (NLP). Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: In Appendix A, "Kinaesthetic" should be --Kinesthetic--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are considered improper because they do not include any transitional phrases. These claims are unclear to the examiner because there is no transitional phrase separating the preamble from the body of the claim. As a result, the examiner is not able to determine the "Metes and Bounds" of these claims. Please see MPEP 2111.03. Claims 2-12 are also rejected because they depend on claim 1. For claims 1-9, the preamble recites a method for arranging visual information but the claimed invention does not include any steps for performing this method. There seems to be a clarity issue as to what the method is actually intended to

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do. Claims 2-9 are also rejected because they depend on claim 1 and do not correct this problem.

6. Claims 11 & 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language.

This claim is an omnibus type claim.

7. Regarding claims 1-9, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 1, 8, 11 & 12, the claimed invention does not produce a concrete result. In order for a result to be concrete there must be a reasonable expectation of success, or the result must be assured. At least the limitations, "that direction will stimulate the area of the brain most related to learning the type of information outlined in the claim", "different forms of information will also have the effect of improving the intelligence of the reader", "the process of learning will be enhanced by the use of certain types of words in certain areas" and "different ways will increase the "mental agility" of the brain and so help to maintain the reader's mental vigor into old age" fail to produce a concrete result. Although one user brain might be stimulated, improve intelligence, the process of learning will be enhanced and/or

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increase "mental agility" this is not a guaranteed result for all users. There is no evidence to suggest that this result is even expected in a vast majority of users, and so such does not meet the requirements of producing a reasonable expectation of success either. None of the dependent claims 2-10 correct this problem so they are also rejected. In addition, in the instant application, how does the user know that certain functions will happen every time this method is used? This is just not the case.

Everyone learns differently which will probably make the assumption untrue sometimes. In addition, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *in re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *EX part Gwin*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 f.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter se-forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate, which they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is no-statutory subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran (U.S. Patent Number 5,007,838).

Referring to claims 1-7, Cochran discloses a method for arranging visual information (column 4 lines 60-63), such as, intellectual and/or creative focus, pictures, kinesthetic information, auditory functions, historical or memory-related, future information, in a way that causes the viewer to move his or her eyes in certain ways to view certain types of information (Figs. 1 & 2: text 90). This eye movement more effectively stimulates certain areas of the brain thus improve learning and retention (column 1 lines 7-15). Cochran discloses all of the information above except for how the information is arranged on the page. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the information arranged in certain areas of the page as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In addition, Cochran discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In*

re Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of arrangement of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the system comprising text is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. the visual information) and the substrate (e.g. the text), which is required for patentability.

Referring to claim 8, Cochran discloses where the process of learning will enhance by the use of certain of words, such as, "sight", "physical" and "sound, in certain areas where those types of words relate directly to the area of brain-access (column 3 lines 4-16).

Referring to claim 9, Cochran discloses where the size of the "page" is larger than the average paperback so as to take up a larger percentage of the viewer's field of vision so as to force the direction of the viewers eyes to more effectively stimulate the brain (Figs. 1 & 2).

Referring to claim 10, Cochran discloses where the "page" may extend across a two-page spread of a book (Figs. 1 & 2).

Referring to claim 11, Cochran discloses that using this process in a layout that uses many different forms of information will also have the effect of improving the intelligence

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of the reader by repeatedly stimulating those many areas of the brain (Figs. 1 & 2 column 1 lines 7-16).

Referring to claim 12, Cochran discloses that stimulating the brain in many different ways will increase the "mental agility" of the brain and so help to maintain the reader's mental vigor into old age (column 1 lines 7-16).

Additional Information

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. Applicant is reminded that the revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

Applicant is advised to arrange the content of the specification as described below:

Content of Specification

- (a) Title of the Invention. (See 37 C.F.R. 1.72(a)). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 C.F.R. 1.78 and section 201.11 of the M.P.E.P. This relates to any other applications that Applicant has pending before the Patent Office.
- ☐ Statement as to rights to inventions made under Federally sponsored research and development (if any): See section 310 of the M.P.E.P.
- (d) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of

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the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field".

- (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art".
- (e) Summary: A brief summary or general statement of the invention as set forth in 37 C.F.R. 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (f) Brief Description of the Drawing(s): A reference to and brief description of each of the drawing figure(s) as set forth in 37 C.F.R. 1.74.
- (g) Description of the Preferred Embodiment(s): A description of the preferred embodiment(s) of the invention as required in 37 C.F.R. 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention". Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (h) Claim(s) (See 37 C.F.R. 1.75): A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. **The claim(s) must be in one sentence form only.** Note the format of the claims in the patent cited.

Claims should be provided on a separate sheet, not at the end of the Specification (pgs. 10-12). Please delete these pages.

- (I) Abstract: The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," *etc.*

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

As per 37 CFR 1.52(b), the application papers must be plainly written (preferably typed) on but one side of the paper. The size of all sheets of paper should be 8 to 8½ by 10½ to 13 inches (20.3 to 21.6 cm by 26.6 to 33.0 cm). Margins of at least approximately 1 inch on the left hand side and ¾ inch on the top must be reserved on each page. The lines on each page should be double spaced to permit the insertion of amendment. The pages of application, including the claims and abstract should be numbered consecutively, starting with 1, the numbers being centrally located preferably below the text.

If Applicant wishes to continue to prosecute this patent application, applicant must reply in writing. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.
6. Name of Applicants.

Applicant's reply should identify the Office Action the amendment is in response to by its mailing date or paper no. and must specifically request further examination and reconsideration. Applicant or Applicant's registered representative must sign the reply.

In a reply to an Office Action, Applicant can amend the specification, drawings and claims to overcome objections and rejections as well as argue against any position taken by the Examiner. Applicant's arguments and other pertinent comments should appear under the heading "REMARKS". In Applicant's remarks, applicant must point

out each error, if any, applicant believes the Examiner has made in the current Office Action and/or how any amendments Applicant has made to the specification, drawings and claims overcome the Examiner's objections and rejections. Applicant must respond to each and every ground of rejection and objection raised in the current Office Action.

To overcome the objection and rejection for lack of an enabling disclosure, Applicant can argue that the holding of non-enabling by the Examiner is in error. To be persuasive, however, such an argument must point out where, in the specification as originally filed, the specification provides the necessary detailed disclosure for supporting the claimed invention. Alternatively, the Applicant could rebut the Examiner's holding of non-enabling by submitting evidence that the disclosure as it now stands is sufficient to enable an artisan, of ordinary skill, to make and use the invention. Such evidence should take the form of patents or literature published before the filing date of Applicant's application. Alternatively, the evidence could take the form of one or more affidavits by skilled in the art, stating facts, and on the basis of their knowledge and skill, establish that, on or before the filing date of Applicant's application, one of ordinary skill in the art could make and use the claimed invention from reading the specification without undue experimentation.

Applicant can amend the specification and drawings by sending the Office a signed letter directing the Office to make the specified alterations. Amendments are governed by 37 CFR 1.121. Amendments to the specification may be made by either

adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification. To delete, replace or add a paragraph the following must be included:

- (i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;
- (ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;
- (iii) The full text of any added paragraphs without any underlining; and;
- (iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

To make an amendment by substitute specification the following must be provided:

- (i) An instruction to replace the specification; and
- (ii) A substitute specification in compliance with §§ 1.125(b) and (c).

Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered). All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)).

The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and are submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by ~~strike-through~~ except that double brackets placed before and after the deleted characters may be used to show deletion of **five or fewer**

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consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.” The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

See 37 CFR 1.121. Sample amendments and common question and answers are posted at:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.h>

tm

Citation of Pertinent Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

LaDue (U.S. Patent Number 6,259,889) teaches an active symbol self design method and apparatus.

Nielson et al. (U.S. Patent Number 6,437,758) teaches a method and apparatus for eye-track-mediated downloading.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kesha Frisby whose telephone number is 571-272-8774. The examiner can normally be reached on Mon. - Wed. 7-3pm & Thurs. - Fri. 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyf
Kyf 10/16/2006

KATHLEEN MOSSER
PRIMARY EXAMINER